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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,469	03/27/2004	David S. Bonalle	03292.101090.21	9765
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FITZPATRICK CELLA (AMEX) 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			BANGACHON, WILLIAM L	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/810,469	BONALLE ET AL.	
	Examiner	Art Unit	
	William L. Bangachon	2612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 27 March 2004.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-7 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-7 is/are rejected.

7) Claim(s) 1-7 is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892) ✓
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO/SB/08) ✓
Paper No(s)/Mail Date _____
4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) Notice of Informal Patent Application
6) Other: EXAMINER REMARKS.

DETAILED ACTION

Remarks

1. In response to the application filed 3/27/04, the application has been thoroughly examined. The Examiner has fully considered the presentation of claims in view of the disclosure and the current state of the prior art. It is the Examiner's position that the application and the claimed invention are not in condition for allowance for the reasons set forth in this Office action:

Information Disclosure Statement

2. It is noted that an excessive number of foreign patents and publication are cited without a legible copy of each foreign patent and publication. It is also noted that an excessive number of cited references are without a concise explanation of the relevance, as it is presently understood by the individual designated in § 1.56(c) most knowledgeable about the content of the information, of each patent, publication, or other information listed that is not in the English language (i.e. The concise explanation may be either separate from applicant's specification or incorporated therein). See 37 CFR 1.98(a)(2).

Priority

3. It is noted that the application is not entitled to the priority date of the parent applications (both provisional and non-provisional applications) cited in the first

paragraph of the specification because the cited parent applications does not disclose calling card application, as claimed in the present application. For examination purposes, the effective date is the filing date of the present application.

Specification

4. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc. In this case, the term 'provided' and 'invention' appears in the abstract. Appropriate correction is required.

Claim Objections

5. Claims 1-7 are objected to because of the following informalities:

It is noted that the clause "**operable to**" is recited in claims 1 and 3. The clause "**configured to**" is recited in claim 6. Such language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure, does not limit the scope of a claim or claim limitation. It is considered not a positive limitation and does not constitute a limitation in any patentable sense. It is suggested that the "**operable to**" and "**configured to**" clause is taken out of the claims to thereby recite a positive limitation. See MPEP 2106. Further, it has been held that the recitation that an element, which suggests of performing an action is not a positive limitation, but only requires the ability to do so. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Appropriate correction is required.

Claim 1 recites the limitation "said second data set". There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.

Claim 5 provides for the use of "said first and second call carrier having no value". Claim 7 provides for the use of "a rating database", but, since the claims does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. It is suggested to include positive steps in the claims, delimiting how this use is actually practiced. See MPEP 2173.05(q). Appropriate correction is required.

Claims 2 and 4 are dependent on claim 1 incorporating the objectionable language and therefore objected to for the same reasons.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-7 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 10-14 of U.S. Patent No. 7,119,659 {hereinafter '659'} in view of US Patent 4,868,849 {hereinafter 'Tamaoki'}.

Claims 10 or 12-14 in '659' reads on the limitations of claims 1-2 and 5-7 in the present invention and claim 11 in '659' reads on the limitations of claims 3 and 4 in the present invention. Although '659' does not claim a "calling card", such calling cards are conventional and would have been obvious in '659', as evidenced by Tamaoki. As such, Tamaoki, in the same field of endeavor (i.e. smart cards), teaches of a telephone operated by a telephone card for the purpose of automatically making calls without requiring the input of a telephone number {see Tamaoki, column 1 and lines 46-50+}. Tamaoki suggests that telephone cards are advantageous because the user need not prepare small change each time the user operates a telephone as compared to a coin-operated telephone {see Tamaoki, column 1 and lines 23-28}. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of applicant's invention, to include calling card or telephone card in '659' because, as evidenced by Tamaoki, a user need not prepare small change each time the user operates a telephone.

8. Claims 1-7 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 11-14 of U.S. Patent No. 7,172,112 {hereinafter '112'} in view of US Patent 4,868,849 {hereinafter 'Tamaoki'}.

Claims 11-14 in '112' read on the limitations of claims 1-2 and 5-7 in the present invention. Although '112' does not claim a "calling card", such calling cards are conventional and would have been obvious in '112', as evidenced by Tamaoki. As such, Tamaoki, in the same field of endeavor (i.e. smart cards), teaches of a telephone operated by a telephone card for the purpose of automatically making calls without requiring the input of a telephone number {see Tamaoki, column 1 and lines 46-50+}. Tamaoki suggests that telephone cards are advantageous because the user need not prepare small change each time the user operates a telephone as compared to a coin-operated telephone {see Tamaoki, column 1 and lines 23-28}. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of applicant's invention, to include calling card or telephone card in '112' because, as evidenced by Tamaoki, a user need not prepare small change each time the user operates a telephone.

In claims 3 and 4, '112' does not disclose, said RFID reader is operable to receive at least one of said first and second call carrier data in magnetic stripe format. However, Tamaoki suggests that magnetic stripe format is advantageous because it can record information related to the telephone card {see Tamaoki, column 3, lines 1-5}. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of applicant's invention, to include the claimed magnetic stripe format language in '112' because, as evidenced by Tamaoki, a magnetic stripe format can record information related to the telephone card.

9. Claims 1-7 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 10 and 14 of copending Application No. 10/708,550 {hereinafter '550'} in view of US Patent 4,868,849 {hereinafter 'Tamaoki'}.

This is a provisional obviousness-type double patenting rejection.

Claim 1 in '550' recites the method in claims 1-2 and 5 in the present invention and claims 10 and 14 recites the system in claims 6-7 in the present invention. Although '550' does not claim a "calling card", such calling cards are conventional and would have been obvious in '550', as evidenced by Tamaoki. As such, Tamaoki, in the same field of endeavor (i.e. smart cards), teaches of a telephone operated by a telephone card for the purpose of automatically making calls without requiring the input of a telephone number {see Tamaoki, column 1 and lines 46-50+}. Tamaoki suggests that telephone cards are advantageous because the user need not prepare small change each time the user operates a telephone as compared to a coin-operated telephone {see Tamaoki, column 1 and lines 23-28}. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of applicant's invention, to include calling card or telephone card in '550' because, as evidenced by Tamaoki, a user need not prepare small change each time the user operates a telephone.

In claims 3 and 4, '550' does not disclose, said RFID reader is operable to receive at least one of said first and second call carrier data in magnetic stripe format. However, Tamaoki suggests that magnetic stripe format is advantageous because it can record information related to the telephone card {see Tamaoki, column 3, lines 1-5}.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of applicant's invention, to include the claimed magnetic stripe format language in '550' because, as evidenced by Tamaoki, a magnetic stripe format can record information related to the telephone card.

10. Claims 1-7 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 and 15 of copending Application No. 10/708,585 {hereinafter '585'} in view of US Patent 4,868,849 {hereinafter 'Tamaoki'}.

This is a provisional obviousness-type double patenting rejection.

Claims 1-3 in '585' recites the method in claims 1-2 and 5 in the present invention and claim 15 in '585' recites the system in claims 6-7 in the present invention. Although '585' does not claim a "calling card", such calling cards are conventional and would have been obvious in '585', as evidenced by Tamaoki. As such, Tamaoki, in the same field of endeavor (i.e. smart cards), teaches of a telephone operated by a telephone card for the purpose of automatically making calls without requiring the input of a telephone number {see Tamaoki, column 1 and lines 46-50+}. Tamaoki suggests that telephone cards are advantageous because the user need not prepare small change each time the user operates a telephone as compared to a coin-operated telephone {see Tamaoki, column 1 and lines 23-28}. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of applicant's invention, to include

calling card or telephone card in '585' because, as evidenced by Tamaoki, a user need not prepare small change each time the user operates a telephone.

In claims 3 and 4, '585' does not disclose, said RFID reader is operable to receive at least one of said first and second call carrier data in magnetic stripe format. However, Tamaoki suggests that magnetic stripe format is advantageous because it can record information related to the telephone card {see Tamaoki, column 3, lines 1-5}. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of applicant's invention, to include the claimed magnetic stripe format language in '585' because, as evidenced by Tamaoki, a magnetic stripe format can record information related to the telephone card.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

15. Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by US 2004/0249839 A1 {hereinafter '839'}.

With regards to claim 6 in the present invention, '839' teach of a system for a transaction instrument (i.e. transaction device) for storing multiple calling card accounts

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numbers distinctly stored on a RF operable transaction instrument 240 {see '839', paragraph 0105},

 said RF transaction instrument 240 comprising

 at least a first data storage area configured to store a first calling card number in a first format and a second data storage area configured to store a second calling card number in a second format different from said first format {see '839', paragraph 0049},

 said first calling card number associated with a first owner and said data storage area configured to store said first calling card number in said first format independent of said second data set {see '839', paragraph 0049, lines 17-26+}.

 In claim 7, '839' teach of a remote calling card validation database 282 {see '839', paragraph 0078}.

 Claim 1 recites a method for practicing the system of claim 6 and therefore rejected for the same reasons.

 In claim 2, '839' further teach, providing at least one of said first and second call carrier data set is formatted to communicate with a RFID reader via RF communications {see '839', paragraphs 0035 and 0105+}.

 In claim 3, '839' teach, said RFID reader is operable to receive at least one of said first and second call carrier data in magnetic stripe format {see '839', paragraphs 0033-0035}.

 In claim 4, '839' teach, said at least one of said first and second call carrier data is in magnetic stripe format {see '839', paragraph 0033-0034}.

In claim 5, '839' teach, providing a calling-card transaction account associated with at least one of said first and second call carrier data, said calling card transaction account having a value associated with transaction account usage, said first and second call carrier having no value related for use in satisfying a transaction account, and wherein said calling card transaction results in a depletion of value of the calling card account {see '839', paragraphs 0119-0120+}.

16. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,747,546 {hereinafter 'Hikita et al'} in view of US Patent 4,868,849 {hereinafter 'Tamaoki'}.

With regards to claim 6 in the present invention, 'Hikita et al' teach of a communication system for a IC card (i.e. transaction device) distinctly storing multiple account numbers managed by different providers on a RF operable IC card 3 or 31 or 32 shown in Figures 1, 6 and 10, said RF operable IC card 3, 31, 32 comprising:

a memory 17 divided into several memory areas 17-1 to 17-n configured to store ID numbers of different providers (considered as functionally equivalent to the claimed "at least a first data storage area configured to store a first calling card number in a first format and a second data storage area configured to store a second calling card number in a second format different from said first format") {see Hikita et al, column 4, lines 16-44+};

each memory area is associated with the ID number of the individual providers. The ID numbers are determined by the individual providers {see Hikita et al, column 4

and lines 30-43+; column 7 and lines 22-30+; column 9 and lines 58-67}. This is considered as functionally equivalent to the claimed "said first calling card number associated with a first owner and said data storage area configured to store said first calling card number in said first format independent of said second data set".

Hikita et al does not disclose a "calling card". However, such calling cards are conventional and would have been obvious in the system of Hikita et al, as evidenced by Tamaoki. As such, Tamaoki, in the same field of endeavor, teaches of a telephone operated by a telephone card for the purpose of automatically making calls without requiring the input of a telephone number {see Tamaoki, column 1 and lines 46-50+}. Tamaoki suggests that telephone cards are advantageous because the user need not prepare small change each time the user operates a telephone as compared to a coin-operated telephone {see Tamaoki, column 1 and lines 23-28}. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of applicant's invention, to include calling card or telephone card in the system of Hikita et al because, as evidenced by Tamaoki, a user need not prepare small change each time the user operates a telephone.

In claim 7, Tamaoki teach of a remote card validation database in the form of a controller 31 for administering control sequence stored in a ROM 32 {see Tamaoki, paragraph-bridging columns 2 and 3}. The control sequence includes authorizing telephone card account transactions {see Tamaoki, column 3 and lines 59-67}. The validation database is in communication with an ordinary company, which keeps track of telephone fees {see Tamaoki, column 4, lines 60-66}. Also see Hikita et al regarding a

remote card validation database in communication with a rating database, as claimed {see Hikita et al, column 10, lines 1-67}.

Claim 1 recites a method for practicing the system of claim 6 and therefore rejected for the same reasons.

In claim 2, Hikita et al teach, each IC card 3 can communicate with a plurality of RFID reader/writer {see Hikita et al, column 4, lines 16-18}.

In claims 3 and 4, Hikita et al does not disclose, said RFID reader is operable to receive at least one of said first and second call carrier data in magnetic stripe format. Tamaoki suggests that magnetic stripe format is advantageous because it can record information related to the telephone card {see Tamaoki, column 3, lines 1-5}. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of applicant's invention, to include the claimed magnetic stripe format language in the system of Hikita et al because, as evidenced by Tamaoki, a magnetic stripe format can record information related to the telephone card.

Claim 5 recites a method for practicing the system of claim 7 and therefore rejected for the same reasons.

Office Contact Information

17. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to William Bangachon whose telephone number is (571)-272-3065. The Examiner can normally be reached from Monday through Friday, 9:00 AM to 5:30 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Brian Zimmerman can be reached on **(571)-272-3059**. The fax phone numbers for the organization where this application or proceeding is assigned is **571-273-8300** for regular and After Final formal communications. The Examiner's fax number is **(571)-273-3065** for informal communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866-217-9197** (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.



William L Bangachon
Examiner
Art Unit 2635

May 9, 2007



BRIAN ZIMMERMAN
PRIMARY EXAMINER